

REMARKS

Claims 1 through 25 are pending in this application. The Applicant appreciates the indication of allowability of claims 2 through 12, 14, 15, 17 through 20, and 22 through 25.

A. The Double Patenting Rejection

The examiner stated that claims 1, 13, 16, and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,233,026 by Kim and Lee (*Kim et al.* '026). The examiner admits that the conflicting claims are not identical but states that they are not patentably distinct from each other. As seen below, the obviousness type double patenting rejection is improper.

1. Concerning claims 1, 13, 16, and 21, under a 35USC§103 analysis for a double patenting rejection, *Kim et al.* '026 does not teach or suggest all the claimed limitations of the present invention as defined by the claims of *Kim et al.* '026.

On page 2 of paper number 19, the Examiner admits that *Kim et al.* '026 does not claim the rear casing, but instead claims the lower shield which is not present in the presently claimed invention. However, the Examiner argues that the use of a rear casing would be obvious as the pins of the front casing would, of necessity, engage with something and this would be a rear casing. Respectfully, the presently claimed invention involves the interconnection of certain members. To say that other pins or connection that may be assumed to connect to the rear casing does not then

make an obviousness type double patenting rejection in light of *Kim et al.* '026. This reasoning would be improper because this involves a different set of interconnections. The fact is that as the Examiner admits, the rear casing is not claimed by *Kim et al.* '026 and therefore, there cannot be an obviousness type double patenting rejection. There are policy reasons that were set to safeguard against improper rejections when applications are commonly owned. The set procedure shows that the present invention is claiming different sets of limitations. The purpose of double patenting is to prevent improper lengthening of the patent term. If a certain limitation is not claimed then there is no double patenting. The Examiner is arguing that the connection between the front case and the rear case is obvious in regards to the front case and a lower shield because the rear case would be involved anyway. However, this logic does not address the specific connections that the present invention is claiming. The fact is that the connections are different as seen specifically below. Furthermore, by suggesting of a different type of connection with the rear case, the patent would then be teaching away from the present invention.

If the Examiner instead wants to use the disclosure instead of the claimed subject matter of *Kim et al.* '026 as reason for rejection, then he needs to form a 35USC§103 obviousness type rejection rather than an obviousness type double patenting rejection. However, because of the new rules affecting 35USC§103(c), even a obviousness type rejection would be improper using *Kim et al.* '026.

As mentioned in claims 1, 13, 16, and 21, the engaging pin (reference 80 of the present invention) at the lower rear surface of the front casing (reference 51 of the present invention) is not

mentioned in the claims of *Kim et al.* '026. For example in claim 10 of *Kim et al.* '026, it is mentioned that "a front case having a rear side and a pair of guide rails extending rearward from the corners on said rear side thereof..." The pair of guide rails as seen in col. 4, lines 31-34 of *Kim et al.* '026, refers to reference 52 which accepts protruding ribs 56. On the other hand, in the present invention in claim 1 for example, the first hole of the lower portion of the front surface of the rear casing, is separately engaged to the engaging pin and the snap pin engages the first hole accommodating the prevention of the engaging pin from detaching from the first hole.

Furthermore, Applicant's claims 1, 13 and 16, and 21 illustrate an apparatus that is structurally, functionally and operationally different from the combination set forth in the claims of *Kim et al.* '026. Whereas Applicant defines a novel combination of a front casing, rear casing and an engaging snap pin, *Kim et al.* '026 defines a different front case section, rear case section, first guide and second guide means, in conjunction with a snapping device pull for engagingly locking a printed circuit board. In fact *Kim et al.* '026 is teaching away from the claimed invention by disclosing the snap engaging a bottom shield instead of the snap engaging with the rear casing as seen in the presently claimed invention. All of the claims of *Kim et al.* '026 (claims 1-23) explicitly teach a "bottom shield" that snap fits with the front case.

2. Concerning Claims 1, 13, 16, and 21, the connection of the front case to the rear case of the present invention is not an obvious variation of the connection of a bottom shield with the front case of the patent of *Kim et al.* '026.

The examiner mentions on page 2 of paper number 19 that a rear casing would be obvious as the pins of the front casing would, of necessity, engage with something and this would be a rear casing. As mentioned in all the claims of *Kim et al.* '026, in column 1, lines 15-17 of U.S. Patent 6,233,026 mentions that the bottom shield which easily engages with a front case. *Kim et al.* '026 is even entitled "Monitor Comprising Snap Engaging Bottom Shield." (emphasis added). The presently claimed invention specifically mentions the front case snap fitting with the rear case and not the front case snap fitting with the bottom shield. There is a structural difference between the disclosure of the prior art patent to the extent that it is claimed in the presently claimed invention.

As mentioned in MPEP§804, the obviousness type double patenting parallels the guidelines for a 35USC§103 rejection. According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As required in the third element of the *prima facie* case, the prior art references do not teach or suggest the limitation of the front case connection with the rear case but instead shows specifically the bottom shield with the front case in the patent. The Examiner only states that because the rear

casing must connect somehow, then it would be obvious to use the connection to connect to the rear casing rather than the lower shield. However, this logic is flawed, because specifically, *Kim et al. '026* does not involve those specific connections to the rear casing but to the lower shield. The MPEP §706.02(j) demands that “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.” The examiner, instead, is using the disclosure in the present invention instead of using the reference that are being relied upon.

The Examiner only states that through necessity the rear case must be engaged anyway since the pins of the front casing would of necessity engage something and this would be a rear casing. The pins of the front casing of the patent that the Examiner is mentioning are a different set of pins and therefore, clearly an obviousness type double patenting rejection would be improper.

3. The examiner failed to show a proper motivation to modify the patent.

Respectfully, the examiner failed to show a proper motivation to modify the patent to use specific interconnections to connect to the front and rear casing rather than the front and lower shield as claimed in *Kim et al. '026*. The Examiner only states that through necessity the rear case must be engaged anyway since the pins of the front casing would of necessity engage something and this would be a rear casing. However, clearly then *Kim et al. '026* is actually teaching away from the presently claimed invention if the Examiner is stating that a different set of connections are disclosed by *Kim et al. '026* for connections of the front and rear casing. “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure

as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 50 USPQ.2d 1614 (Fed. Cir. 1999).

4. The method claim 21 is improperly rejected under an obviousness type double patenting rejection because the claims are not obvious under 35U.S.C. §103(a) over *Kim et al.* '026.

Concerning method claim 21, respectfully, the Applicant's process claim 21 is improperly rejected by the apparatus claims of *Kim et al.* '026; these claims are statutorily different in class and in subject matter. Respectfully, the Examiner has neglected to explain either the application of *Kim et al.* '026 or his interpretation of those claims to support a comparison of each of the limitation set forth in the Applicant's method claim 21.

Further, all the claim limitations of claim 21 are not taught or suggested by *Kim et al.* '026. For example, *Kim et al.* '026 does not teach or suggest the “forming a rear casing ... forming a snap pin.” Further, there is no teaching or suggestion of the snap pin comprising of “forming a polygonal upper body ... forming a lower body ... dividing one end of lower body ... forming a connection portion.” Respectfully, the examiner's rejection is improper.

B. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 1, 16, and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Beak (U.S. Patent 5,863,106, referred to hereafter as *Beak '106*).

According to MPEP 706.02(j), a *prima facie* case of obviousness under 35 U.S.C. §103 must be established by the examiner.

1. *Beak '106* does not teach or suggest all the claim elements of the present invention.

Concerning Claims 1, 16, and 21, the examiner mentions that *Beak '106* discloses a monitor which includes an engaging pin (11 and 11') at the bottom of the front case which is received in a slot in the rear case (42, 42'). Respectfully, however, as pointed out in *Beak '106* in col. 3, lines 20-30, and lines 58-65, and figure 3, reference 11 and 11' holds a printed circuit board (PCB) 31 and not the rear case section. Member 42 and 42' do not receive reference 11 and 11', but they receive the printed circuit board 31. In col. 1, lines 1-10 of *Beak '106*, it mentions that the engaging pin relates to a structure affixing a printed circuit board within a monitor case. In col. 4, lines 36-40 of claim 1 of *Beak '106*, it states that the first guide affixes the printed circuit board. Therefore, *Beak '106* discloses a different structure than the present invention, and so does not teach or suggest the claimed present invention.

The Examiner on page 3 of paper number 19 states that *Beak '106* discloses the unnumbered

features around the periphery of the rear case as seen in figure 1. However, if these are also engaging pins, then there is no mention of the snap pins. Even if the pins around the periphery and feature 11 are two different types of pins (one being the snap pin and the other the engaging pin), one pin does not prevent the other pin from detaching the front case from the rear case. It is not clear from the drawing alone that the pins around the periphery of the case can prevent the case from disengaging. As shown above, feature 11 is involved in holding the printed circuit board in place. Therefore, *Beak '106* does not teach or suggests a snap pin that prevents the engaging pin from detaching as mentioned in claim 1 of the present invention. Both the snap pin and the engaging pins connect between the front case and rear case. *Beak '106* does not teach or suggest both structures interacting together in the manner presented in the claims of the present invention.

Furthermore, *Beak '106* does not teach or suggest the relationship of the engaging pin (80) at the lower rear surface of the front casing (51), the snap pin (100), and the first hole (90) on the lower portion of the front surface of the rear casing (53). As mentioned in claim 1, "...a front casing having ...at least one *engaging pin* at a lower rear surface of said front casing...a rear casing having... at least one *first hole* formed at a lower portion of the front surface, said rear casing integrally engaged with said front casing in such a manner that the *first hole* is separately engaged to the *engaging pin*...a *snap pin* engaging in the *first hole* accommodating the prevention of the *engaging pin* from detaching from the *first hole* when the *engaging pin* of the front casing is integrally engaged into the *first hole* of said rear casing." (emphasis added). In *Beak '106*, the engaging pin of the front case does not separately engage with the first hole of the rear case since guide rails 11 and 11'

(correlated to the engaging pins by the Examiner) do not even go into the guide ribs 42 and 42' (correlated to the first hole by the Examiner), but instead goes into the printed circuit board 31. Further, in the present invention, the snap pin provides a further connection to the same first hole that is connected already engaging with the first hole. Therefore, the same first hole accommodates the engagement of the engaging pin and the snap pin. *Beak '106*, however does not teach or suggest the snap pin engaging with the first hole. As seen in *Beak '106*, the first hole (guide ribs 42 and 42') is engaged with the printed circuit board 31 and not the snap pin (the examiner correlates the snap pin to the receiving section of the slot (below feature 12 of Fig. 4)) of *Beak '106* as seen in paper number 8, page 4 when the examiner states that it engages the engaging pin and hold it in place) . The receiving section is not engaged with the same first hole (ribs 42 and 42' of *Beak '106*) and the engaging pin (11 and 11' of *Beak '106*) as seen in Fig. 4 of *Beak '106*. Furthermore, nowhere in the reference of *Beak '106*, does it teach or suggest, that the receiving section will prevent the engaging pin (feature 11 and 11' of *Beak '106*) from detaching. The receiving section has no contact with reference 11 as seen in Fig. 4 of *Beak '106*. No mechanism can be seen to teach or suggest that there is a "prevention from detaching" by the receiving section of the slot (42 and 42' of *Beak '106*) of the rear case in figure 4 of *Beak '106*. Therefore, *Beak '106*, as mandated by MPEP §706.02(j), does not teach or suggest a snap pin preventing the engaging pin of the front case from detaching from the first hole while it is also engaged with the first hole of the rear case.

The Examiner on page 3 of paper number 19 admits that *Beak* does not disclose the snap portion at the top of the casing, but argues that shifting of parts is a matter of obvious design choice

that is well settled in case law with the citation of *In re Japikse* 86USPQ70(CCPA 1950) which, according to the Examiner, states that shifting the location of parts would have been within the general skill of a worker in the art, and that it would have been well within the purview and obvious to shift the location of the portions as claimed.

In re Japikse is not stating that shifting of parts is a matter of design choice. The legal precedent cited by the Examiner is also mentioned in the MPEP §2144.04 which mentions that *In re Japikse* mentions “Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.” In the presently claimed invention, the location of the snap portion would by just looking at the invention show that it would affect the operation of the apparatus.

The Examiner on page 3 of paper number 19, argues that in Beak, the slot has a receiving section with a snap pin (below feature 12 as best seen in fig. 3) that engages the engaging pin to hold in place. Looking very closely at figure 3, the feature below feature 12 is not *engaging in the first hole accommodating the prevention of the engaging pin from detaching from the first hole when the engaging pin of the front casing is integrally engaged into the first hole of said rear casing* as mentioned in claim 1 of the present invention. First of all, the feature below feature 12 is not dealing with the first hole of the rear casing but with the printed circuit board 31. Further, the feature below feature 12 is not preventing the engaging pin from detaching from the first hole of the rear casing. It is not even clear from the arguments what the Examiner is referring to as the engaging pins that

are being prevented from detaching. The Examiner fails to mention what specifically the engaging pins correspond to in Beak that are being prevented from detaching. Further, Beak as seen by the feature below feature 12, does not teach or suggest both the engaging pin and the snap pin engaged with the first hole of the rear case.

The features from the references that the Examiner is using for the rejection are not all entirely clear what they are corresponding to in the present invention. Some features are clear but others are not. The Applicant asks that the Examiner be more clear as to the corresponding features, because some of the terms are being repeated or no corresponding feature is given at all. It would be extremely helpful to the Applicant if the Examiner for all the limitations can be a little more clear as to what feature of the reference corresponds to what particular feature in the present invention.

2. The method claim 21 was improperly rejected under 35 U.S.C. §103(a) over *Beak '106*.

Concerning method claim 21, respectfully, the Applicant's process claim 21 was improperly rejected by the apparatus claims of *Beak '106*; these claims are statutorily different in class and in subject matter. Respectfully, the Examiner has neglected to explain either the application of *Beak '106* or his interpretation of those claims to support a comparison of each of the limitation set forth in the Applicant's method claim 21. For example in paper number 19, page 3, the Examiner stated concerning claim 21, "The method of claim 21 would produce this configuration and is therefore

inherently disclosed.”

The method claims were not proven by the examiner to be inherent in the apparatus claims as mentioned in the MPEP §2112.02.

Further, all the claim limitations of claim 21 are not taught or suggested by *Beak '106*. For example, *Beak '106* does not teach or suggest the “forming a rear casing ... forming a snap pin.” Respectfully, the examiner has failed to make a proper rejection.

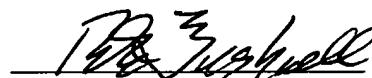
C. ALLOWABILITY OF CLAIMS

The Applicant greatly appreciates the Examiner’s indication of allowability pertaining to claims 2 through 12, 14, 15, 17 through 20, and 22 through 25. In accordance with 37 C.F.R. § 1.111(b), the applicant respectfully requests that the examiner temporarily hold objections and requirements as to form in abeyance until the remarks and amendments in this Amendment are considered by the Examiner.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant’s attorney.

No fee is incurred by this Response. Should there be any other fees, the Commissioner is authorized to charge Deposit Account No. 02-4943 and advise the undersigned attorney accordingly.

Respectfully submitted,



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Folio: P55971
Date: 17 January 2003
I.D.: REB/SS